

REMARKS

This amendment is being filed along with a Request for Continued Examination (RCE) application in response to the Final Office Action having a mailing date of March 9, 2004 (hereinafter "Office Action"). With this amendment, claims 50-97 are pending in the application, as claims 1-49 were previously canceled. Claims 50, 52, 55-56, 58-60, 62, 64-65, 68-71, 73-79, 81-85, 87, 91, and 94 are amended as shown to more particularly point out and distinctly claim applicants' invention. Claims 96-97 are added. No new matter has been added.

Please note that several of applicants claims, including claims 55, 58, 65, 68, and 78, have been amended to recite language that under recent case law is intended to state two or more choices in the alternative and to clarify that the previously recited language is not to be interpreted solely in the conjunctive. Thus applicant has substituted the disjunctive "or" for "and" before the last element in each alternative list so that the claim covers any one or more of the listed elements in the alternative. Namely, the phrase "at least one of A or B" is to be interpreted as including: "A," or "B," or "A and B." Also, the phrases "at least one of A, B, or C," "A, B, or C," and "A or B" are to be interpreted in the same manner. These amendments conform the claims with current case law on this subject.

**Applicants' attorneys kindly request a telephonic interview with the Examiner and her supervisor Safet Metjahic prior to issuance of the next Office Action. It is believed that conducting the interview will help to expedite prosecution of the present application and can assist in further explaining the distinctive subject matter recited in the claims. An Applicant Initiated Interview Request Form (Form PTOL-413A) is included with this amendment. It is requested that the Examiner contact applicants' attorneys upon receipt and review of this amendment to confirm the date and time of the telephone interview.**

I. Introductory Comments

In the Office Action, claims 50-95 were rejected under 35 U.S.C. §112, second paragraph for being indefinite. Claims 50-95 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Beck (U.S. Patent No. 6,332,154) in view of Kumar (U.S. Patent No.

6,353,823). For the reasons set forth below, applicants respectfully disagree with these rejections and request that the pending claims be allowed. As requested by the Examiner on page 10, paragraph 7 of the Office Action, applicants are providing herein specific page and line numbers of the disclosure supporting their arguments and various claim amendments.

One or more disclosed embodiments will be discussed below in comparison to the applied references. Of course, the discussion of the disclosed embodiments, and the discussion of the differences between the disclosed embodiments and subject matter described in the applied references, do not define the scope or interpretation of any of the claims. Instead, such discussed differences are intended to merely help the Examiner appreciate important claim distinctions discussed thereafter.

II. 35 U.S.C. §112, Second Paragraph Rejection - "External" Information System Recited in Claims 50, 69, 75, 79, and 85

The Examiner rejected claims 50, 69, 75, 79, and 85 because she views the term "external information system" as "indistinct" and because Figure 1 of the present application allegedly shows "a plurality of information systems ... 110, 114, 130, etc." See Office Action, page 2, paragraph 3. Applicants' respectfully disagree with this rejection for the following reasons.

First, Figure 1 does not show a "plurality of information systems" as alleged. An object "information systems" is clearly labeled at 130 in Figure 1, and is the only "information systems" labeled in Figure 1. Contrary to the Examiner's allegation, the reference 114 denotes terminals, such as personal computers (PCs), and these terminals are not labeled as "information systems" in Figure 1. See, e.g., page 8, lines 11-17 of applicants' disclosure, which provides additional details regarding the terminals 114. Similarly, the reference 110 refers to a network, and is not labeled or described as an "information systems" in Figure 1 and the accompanying text. See, e.g., page 8, lines 5-8.

Second, to provide further clarification, claims 50, 69, 79, and 85 are amended to recite receiving a plurality of electronic documents from "an information system that is external to the computer system [for] analyz[ing] data," which was introduced in each respective

preamble. Claim 75 is similarly amended to recite “an information system that is external to the computer system.” This language is supported in an example embodiment shown and described in applicants’ specification. The conversion engine 134 and the database system 120 comprise parts of the “computer system for analyzing legal data.” As clearly shown in Figure 1, the information systems 130 is “external” to the conversion engine 134 and to the database system 120. *See, e.g.*, page 11, lines 15-22. The arrows leading from the information systems 130 and/or from the storage media 132 to the conversion engine 134 represent delivery to (receipt of) the electronic files by the computer system for analyzing legal data. With these amendments to claims 50, 69, 75, 79, and 85, applicants respectfully request the Examiner to withdraw these indefiniteness rejections.

III. 35 U.S.C. §112, Second Paragraph Rejection of Claims 56, 70, 76, and 81

Claims 56, 70, 76, and 81 were rejected as indefinite because the Examiner believes that applicants have failed to disclose “when is the time of the claimed ‘commencement of the legal proceeding’.” *See* Office Action, page 2, paragraph 3. Applicants respectfully disagree with this rejection.

In the context of a legal proceeding such as a lawsuit, it is commonly known in the legal field that timing, such as “commencement” of a legal proceeding, is governed by applicable rules, for example the Federal and State Rules of Civil Procedure. Therefore, applicants disagree that use of the term “commencement” of a legal proceeding is indefinite. However, to facilitate prosecution, claims 56, 70, 76, and 81 are amended to delete the term “commencement,” rendering the Examiner’s rejections under 35 U.S.C. §112, second paragraph moot. Applicants therefore request respectfully request the Examiner to withdraw this rejection.

IV. No Prior Art Rejections of Claims 56, 70, 76, and 81

On page 3, paragraph 4 of the present Office Action, the Examiner stated that no prior art rejection “was applied” to claims 56, 70, 76, and 81 because of “their ambiguous nature.” As discussed above, there is no ambiguity in these claims.

Moreover, these claims are allowable over Beck and the other cited references, because neither Beck nor Kumar, alone or in combination, teach, suggest, or motivate receiving or loading “some electronic files that have been previously exchanged between the at least one party and another party prior to the legal proceeding,” such as recited in claims 56, 70, 76, and 81. Instead, the email communications of Beck are *ongoing* communications (*e.g.*, live communications) directly between a customer and a customer service representative (agent) that uses the CRM system of Beck, and do not involve a delivery (to the agent from the customer) of *previously communicated* emails between the customer and some other individual prior to *any* legal proceeding. *See, e.g.*, Figure 15 of Beck. Thus, claims 56, 70, 76, and 81 are allowable.

V. 35 U.S.C. §103(e) Rejection - “User Interface” and “Annotation[s]” in Dependent Claims 64-65, 74, and 94

Amended dependent claim 64 recites “a user interface to display an electronic file having the specified characteristic and that is responsive to the request, and wherein the user interface is usable to apply legal annotations to the electronic files.” Amended dependent claim 65 (which depends from claim 64) recites that the legal annotations include at least one of “reviewed, privileged, hot, responsive, or witness preparation” annotations. *See, e.g.*, the selectable processing boxes 450 in the embodiment of the user interface depicted in Figure 4 that can be used to apply the annotations and the electronic file (the email “Document: 12345ABCDE”) displayed on the user interface; and page 24, lines 1-4 of applicants’ disclosure.

The terms “reviewed, privileged, hot, responsive, or witness preparation” corresponding to these annotations have significance in the legal profession, are commonly known, and are described in applicants’ specification. *See, e.g.*, page 1, line 14 through page 2, line 6; and page 7, lines 19-22 (discussing “reviewed” documents). *See also*, page 1, lines 18-21 (discussing an example of a “hot document”); page 1, line 24 through page 2, lines 1-3 (discussing “responsive” replies to discovery requests); page 24, lines 2-4 (discussing whether a document is suitable for “witness preparation”); and so forth.

In rejecting claims 64-65 on pages 7-8 of the Office Action, the Examiner cited to the table 287 in Figure 14 of Beck and the associated text. An examination of Figure 14 of Beck

and the accompanying text clearly indicates that the table 287 does not include a user interface to “display an electronic file” and that is “usable to apply annotations” as recited in claims 64 and 65, wherein the annotations include “reviewed, privileged, hot, responsive, or witness preparation” as recited in claim 65. Rather, table 287 merely lists types of “tasks” (such as Task 1: Pre-Qualify for a loan application process) of business procedures, and also labels the beginning, end, and actual time to perform such tasks. *See also* col. 35, lines 3-8 of Beck. There is absolutely nothing in Beck that suggests that these “Task”, “Time Begin”, etc. labels in the table 287 are “annotations” of a legal nature as recited in claim 65. Moreover, the table 287 does not “display an electronic file,” as recited in claim 64 (and shown by way of example in Figure 4 of applicants’ disclosure). Instead, only tabular data is displayed.

Also, as described during previous amendments/responses filed during prosecution of the present application, the system of Beck relates to a customer management relationship (CRM) system for business purposes. Thus, a person skilled in the art would not seek to modify Beck’s table 287 listing business tasks in order to generate an interactive user interface for legal use, such a user interface that displays a representation of an electronic file and through which legal annotations can be applied to the electronic file. Accordingly, Beck does not teach, suggest, or motivate claims 64-65.

Amended dependent claim 74 recites “legal annotation selections to apply to the copy of the electronic file.” *See, e.g.*, the selectable boxes 450 in Figure 4 of applicants’ disclosure, which can be applied to the displayed copy of the email, and also page 15, lines 13-17. The Examiner has cited col. 10, lines 17-34 (describing Figure 5) of Kumar to reject claim 74. However, Figure 5 of Kumar merely shows disk drive window 150, a pointer 160, and application program icons 140-148. There is nothing disclosed, taught, or suggested by Kumar in Figure 5 that can in any way be construed as “selectable legal annotations” (or any other type of annotation for that matter) that can be applied to a *presented copy* of an electronic file. Accordingly, claim 74 is not taught, suggested, or motivated by Kumar and is allowable.

Dependent claim 94 recites the allowable features of “legal annotation tools on a user interface that is arranged to present a copy of an electronic file.” For the same reasons

discussed above, this claim is also allowable, since Beck nor Kumar disclose, teach, suggest, or motivate, alone or in combination, “legal annotations” to an electronic file.

VI. 35 U.S.C. §103(a) Rejection of Claims 50-95 based on Beck and Kumar

In general, the Examiner asserts that Beck discloses most of the features recited in the claims. However, the Examiner has admitted on page 4 of the Office Action that Beck does not specifically disclose a technique to index metadata. The Examiner asserts that Kumar supplies this missing aspect. For the reasons set forth in detail below, applicants respectfully disagree with these rejections, and maintain that neither Beck nor Kumar, alone or in combination, teaches, motivates, or suggests one or more aspects of each of claims 50-95. Thus, claims 50-95 are allowable.

A. Analyzing data produced for legal purposes, and variants thereof, recited in claims 50-97.

Each of the independent claims 50, 69, 75, 79, and 85 (and their subsequent dependent claims by virtue of incorporation) recite “analyz[ing] data produced for legal purposes.” *See, e.g.*, Figure 4 and accompanying description. Claim 50 has been further amended to recite “facilitating processing of the determined set of electronic files for legal purposes,” which further emphasizes the distinction between the claimed subject matter in claims 50-68 and Beck. *See, e.g.*, page 29, line 22 through page 30, line 4, etc. This feature is simply not taught, suggested or motivated by either Beck or Kumar, alone or in combination, and thus claims 50-97 are allowable.

Specifically, the system of Beck does not involve “analyzing data produced for legal purposes.” In rejecting claim 50 on the basis of this claim recitation, the Examiner cited items 191 and 193 in Figure 7 and col. 22, lines 12-14 of Beck. However, item 191 is a “text-based” section of a repository 187 (*see, e.g.*, col. 20, lines 61-63 of Beck), and item 193 is referred to as an “automated services system” to “mirror” text-based communications (*see, e.g.*, col. 22, lines 3-9 of Beck). There is nothing in these descriptions or Figure 7 to suggest that the system of Beck can be used by a legal professional (such as a lawyer) for “analyzing data produced for legal purposes.” Indeed, since the services system 193 is “automated,” there would

be no capability for the lawyer to analyze legal data, since the “automated” nature of the services systems 193 would preclude such interaction. In short, the item 191 is merely a repository of text data, and the services system 193 only serves to mirror that data.

The text passage cited by the Examiner (col. 22, lines 12-14 of Beck) refers to “legal papers.” This discussion merely states that legal papers, as an example of a type of “physical text-documents,” are “scanned” into the text section 191 “before they are sent to clients.” Beck is completely silent as to any sort of analysis associated with these documents. They are merely “sent to clients.” No mention is made in Beck of analyzing them for a legal proceeding, as recited in applicants’ claims. The Examiner is reading Beck too broadly by construing the “scanning of the legal papers” of Beck to be the same as the claimed “analyzing data produced for legal purposes.” That is, the Examiner incorrectly assumes that simply because the papers are “legal” in nature, they must have been produced and will be analyzed for “legal purposes,” when in fact, the scanning and storage is merely part of a transaction-tracking process of Beck. This transaction-tracking process is completely different from “legal purposes” recited in claims 50-97, as described in prior remarks to office actions.

As an illustration analogous to Beck, a student in a business class may email a draft contract agreement to a teacher as a homework assignment to be graded. The contract agreement is, by nature, a “legal paper.” However, the contract agreement was not “produced for legal purposes” by the student. Rather, the contract agreement was sent as part of a homework assignment to be graded, which is not a “legal purpose.”

Kumar has nothing to do with legal papers or proceedings. Therefore, since neither Beck nor Kumar, alone or in combination, teach, motivate, or suggest the aspect of “analyz[ing] data produced for legal purposes,” claims 50-97 are allowable.

B. “Directory Structure” recited in claims 50-68, 78, 88, 89, 96, and 97

Although the above reasons are sufficient to distinguish claims 50-97 over the prior art, applicants note that claims 50-68, 78, 88, 89, 96, and 97 continue to be distinguishable for additional reasons. For example, claim 50 as amended recites receiving electronic files that are “stored in a data structure according to a directory structure” (*see, e.g.*, page 16, lines 15-18

of the present application). In addition, claim 50 as amended recites “preserving directory structure information of the received data structure” (*see, e.g.*, page 16, lines 2-4 and 24-25 of the present application). The “directory structure” is a distinctive feature that was previously recited in claim 58 and is now recited explicitly in amended claim 50, and thus is incorporated in all of claims 50-68, and in new dependent claims 96-97. The recited “directory structure” is not found in Beck. The Examiner is requested to refer to the discussion on page 20, lines 5-13 and on page 22, lines 9-15 (regarding claim 58) of the remarks filed by applicants on December 3, 2003. In summary, applicants argued and continue to argue that the system of Beck does not receive electronic files that are stored in a data structure arranged according to a “directory structure.” Rather, Beck receives random individual emails, faxes, etc. that in no way, shape, or form are received as being arranged in a directory structure. Thus, claims 50-68, 96, and 97 recite an additional aspect not taught, suggested or motivated by Beck, and are thus allowable.

Applicants further note that the Examiner continues to ignore the “arranged in a directory structure” recitation in other claims as well. For example, in rejecting claim 58 on the top of page 6 and in rejecting claims 78, 88, and 89 on page 9 of the present Office Action, the Examiner does not address this aspect. Thus, claims 58, 78, 88, and 89 are also similarly allowable.

Amended claim 50 (and thus claims 51-68 by virtue of incorporation) also recites “preserving directory structure information.” There is nothing disclosed, taught, or suggested in Beck or Kumar, alone or in combination, regarding this feature. Both Beck and Kumar completely silent as to receiving electronic files arranged in a directory structure, let alone preserving that directory structure. Thus, since these additional aspects are also not taught, motivated, or suggested, claims 50-68 are also allowable.

C. “Recursively extracting” or “recursive engine” recited in claims 69-78 and 85-97, and in dependent claims 60-63 and 82-83

Claims 69-78 and 85-97 recite a “recursively extracting” feature, which is nowhere taught, suggested, or motivated by Beck or Kumar, alone or in combination. Specifically, independent claim 69 recites “recursively extracting from the data structure the



plurality of electronic files.” Similarly, independent claim 75 recites “recursively extracting the plurality of electronic files from the loaded data structure.” Also, similarly, independent claim 85 recites “at least one recursive engine to receive ... a plurality of electronic files....” An example embodiment of recursive extraction is described on page 16, line 20 through page 17, line 12 of applicants’ specification.

The Examiner did not address this feature specifically in rejecting claims 69, 75, and 85. However, in rejecting dependent claim 60, which recites similar language, the Examiner cited to col. 37, lines 23-27 of Beck and col. 13, lines 13-21 of Kumar as describing “recursively extracting.” *See, e.g.*, page 6 of the Office Action. Applicants disagree with the Examiner’s position.

The section of Beck cited by the Examiner does not describe a recursive process, let alone a recursive extraction process. Rather, it merely discusses stopping a process, allowing more allotted time for a task or sub-task to complete, and repeating the task. In the example provided by Beck, the “tasks” relate to steps involved in processing a loan. There is nothing disclosed, taught, or suggested to indicate that any of these tasks are performed *recursively*. Moreover, applicants’ claims 69-78 and 85-97 recite “*recursively extracting electronic files* from a data structure.” Nothing (not even an electronic file) is being “recursively extracted” in Beck—rather, tasks are merely being executed.

Similarly, the section of Kumar cited by the Examiner also does not describe a recursive process, let alone a recursive extraction process. Rather, it merely discusses a “search” for files, such as images. Kumar makes no mention of whether this searching is performed “recursively.” The “search” in Kumar simply attempts to locate a file, and is not a “recursive extraction process” as claimed.

Thus, because claims 69-78 and 85-97 recite the “recursive extracting” feature, which is not taught, suggested, or motivated by Beck or by Kumar, these claims are allowable over the cited references.

Dependent claims 60-63 and 82-83 also recite the recursive feature and, therefore, are also allowable. For example, dependent claim 60 additionally recites that the plurality of electronic files are recursively extracted from “a plurality of paths of a data structure that is

received from the external information system.” See, for example, page 16, lines 22-25 and original claim 14 of the present application. There is nothing involving recursive extraction of electronic files from a “plurality of paths” of a data structure in any of the cited references.

Thus, the “recursive extraction” aspect is not taught, suggested, or motivated by Beck or Kumar, alone or in combination, and claims 60-63, 69-78, 82-83, and 85-97 are thus allowable.

D. Types of “legal proceeding” recited in dependent claim 55

Dependent claim 55 recites that the legal proceeding is a “discovery proceeding that is part of a lawsuit,” a “mergers and acquisitions proceeding,” or a “due diligence effort.” See, e.g., page 29, line 22 through page 30, line 8 of applicants’ specification disclosure. In rejecting this claim on page 5 of the Office Action, the Examiner stated that these proceedings are “the default nature of proceeding for legal paper.” Applicants disagree with this assertion by the Examiner. Legal papers do NOT have a “default nature,” nor are “default natures” (even assuming that legal papers have a default nature) necessarily the discovery part of a lawsuit, mergers and acquisitions, due diligence, etc.

The types of legal proceedings enumerated in claim 55 are specific types of legal proceedings, which are in no way disclosed, taught, or suggested by the cited references. Beck, in particular, cursorily mentions “legal papers” in col. 22, lines 12-14, and clearly does not indicate that these legal papers are to be used for discovery, mergers and acquisitions, or due diligence. There is no discussion or suggestion in Beck that a company is being sued or being purchased, for example.

Moreover, not all legal papers eventually become involved in a legal proceeding. For instance, an example of a “legal paper” may be a shrink-wrap license that accompanies a computer software’s packaging. Typically, a consumer purchases the software, agrees to the shrink-wrap license by opening the packaging, and either places the shrink-wrap license in a file or throws it away. It cannot be said that the default nature of this shrink-wrap license is discovery, merger, acquisition, or due diligence, particularly since the shrink-wrap license described was filed away to be forgotten or thrown away. In short, claim 55 recites allowable subject matter not taught, suggested, or motivated by any cited reference.

E. “Storing [or obtaining] and indexing threading information” recited in dependent claims 57, 72, 77, and 87

Claim 57 recites, *inter alia*, “storing and indexing threading information associated with the emails.” Claims 72, 77, and 87 recite similar language. As referred to in the specification, a “conversational thread” of email messages provides an association of emails that relate to an email conversation. *See, e.g.*, page 22, line 24 through page 23, line 9 of applicants’ disclosure.

On page 5 of the Office Action, the Examiner rejected claim 57 in view of Kumar (*citing* the unit 107 of the Metadata File Index 10 of Figure 3; col.7, lines 52-53). There is nothing in this section of Kumar that relates to storing and indexing “threading information” of emails. The cited section of Kumar simply mentions a “source address” of a file, which does not necessarily have anything to do with a threaded email discussion. Accordingly, claims 57, 72, 77, and 87 are allowable.

F. Contents specified in a “request” as recited in dependent claim 68

Dependent claim 68 recites receiving a request that specifies at least one of the listed items (such as a word, a recipient of an email, etc.). On page 8 of the Office Action, the Examiner has cited col. 33, lines 17-19 of Beck as disclosing a request that specifies “properties information associated with the electronic file.” However, the cited section of Beck merely mentions receiving a request to access, and is completely silent as to the specific contents of the request (*e.g.*, the request of Beck does not even specify the properties information associated with the electronic file, as the Examiner has asserted). Clearly, Beck does not teach, motivate, or suggest any one or more of the items enumerated in claim 68, and therefore claim 68 is allowable.

G. Other features recited in dependent claims 86-87, 90-93, and 95

Dependent claims 86-87, 90-93, and 95 recite additional features that are described with reference to Figures 2-3 of applicants’ disclosure. For example, claim 92 recites a “virtual directory” (such as the virtual directory 342 of Figure 3). However, despite these

recited distinctive features that are detailed in these claims, the Examiner nevertheless gave the claims a blanket rejection on page 9 of the Office Action, by stating that these features are deemed “to be made obvious by the implementation of the method of claims 50-55 and 57-74.”

The Examiner’s reasoning goes against established patent doctrines. Many different implementations of the methods of claims 50-55 and 57-74 are possible. Therefore, it is not obvious that the example embodiment shown in Figures 2-3 would be obvious. According to well-accepted legal principles, some suggestion of the recited implementation must be found in the prior art. Moreover, even if a particular method is known in the prior art (which applicants assert here is not the case), a new device for performing the allegedly known method still can be patentable.

In the present application, dependent claims 86-87, 90-93, and 95 (as well as their corresponding independent claim 85) recite novel and non-obvious structural features that do not appear to have been given due consideration by the Examiner. For example, claim 92 recites a “virtual directory,” but nowhere does Beck or Kumar disclose, teach, motivate, or suggest this feature. As other examples, claim 87 recites “at least one controller ... to determine a server unit to which to sent the extracted electronic files”; claim 90 recites “at least one administrative program to generate catalog and database parameters that reference the second server unit and the metadata stored therein”; claim 93 recites “user authentication,” “user information,” and “administration” units; and so forth. Thus, claims 86-87, 90-93, and 95 (and other similarly rejected claims) are allowable.

## VII. Concluding Remarks

Overall, none of the references alone, or in any motivated combination, teach, motivate, or suggest one or more aspects that are recited in independent claims 50, 69, 75, 79, and 85. Thus, given the above amendments and accompanying remarks, the independent claims are now in condition for allowance. The dependent claims that depend directly or indirectly from these independent claims are likewise allowable for at least the same reasons, because they incorporate these aspects. In addition, many of the dependent claims recite additional aspects that are not taught, suggested, or motivated by the cited references.

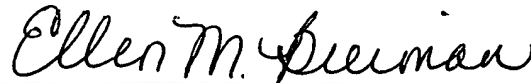
All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

If applicants' representatives have overlooked a teaching in any of the cited references that is relevant to the allowability of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone by telephonic interview with the Examiner and her supervisor or otherwise by telephone, the Examiner is encouraged to contact applicants' representatives at (206) 622-4900.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,

SEED Intellectual Property Law Group PLLC



Ellen M. Bierman

Registration No. 38,079

DMD:asl

Enclosures:

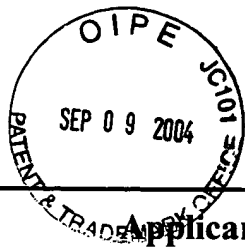
Postcard

Request for Continued Examination (RCE) Transmittal

Applicant Initiated Interview Request Form

701 Fifth Avenue, Suite 6300  
Seattle, Washington 98104-7092  
Phone: (206) 622-4900  
Fax: (206) 682-6031

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**Applicant Initiated Interview Request Form**Application No.: 09/520,264First Named Applicant: Michael C. WeaverExaminer: Chen, Te Y.Art Unit: 2171Status of Application: Pending—RCE  
with amended claims filed in response to  
a Final Office Action having a mailing  
date of 03/09/04**Tentative Participants:**

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Seed IP Law Group

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Proposed Date of Interview: 09/22/2004Proposed Time: 1:00 EST (PM)**Type of Interview Requested:**(1) ☒ Telephonic (2) ☐ Personal (3) ☐ Video ConferenceExhibit To Be Shown or Demonstrated: ☐ YES ☒ NO

If yes, provide brief description: \_\_\_\_\_

**Issues To Be Discussed**

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Not Agreed
(1) Rejection	Dep. claims 64-65, 74, and 94	Beck and Kumar	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(2) Rejection	Indep. claims 50, 69, 75, 79, and 85	Beck and Kumar	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(3) Rejection	Indep. claims 69, 75, and 85; dep. claims 60-63 and 82-83	Beck and Kumar	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(4) Rejection	Dep. claim 55	Beck	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

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(5)	Rejection	Dep. claims 57, 72, 77, and 87	Kumar	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(6)	Rejection	Dep. claim 68	Beck	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(7)	Rejection	Dep. claims 86-87, 90-93, and 95	Beck and Kumar	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(8)	Rejection under 35 U.S.C. §112, second paragraph	Claims 50, 69, 75, 79, and 85	N/A	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

☐ Continuation Sheet Attached

**Brief Description of Arguments to be Presented:**

A. With regards to item (1) above, the prior art does not show the "user interface" and the "legal annotation" features as recited in these claims.

B. With regards to item (2) above, the prior art does not show the "analyzing data produced for legal purposes" feature recited in all of the claims. Also, independent claim 50 recites that the electronic files are "stored in a data structure arranged according to a "directory structure," and further recites "preserving directory structure information," which are not shown in the prior art.

C. With regards to item (3) above, the prior art does not show the "recursively extracting" the electronic files from the data structure recited in claims 69 and 75, and a "recursive engine" to extract the electronic files recited in claim 85.

D. With regards to item (4) above, the prior art does not show any sort of legal proceeding involving "discovery," "mergers and acquisitions," or "due diligence."

E. With regards to item (5) above, the prior art does not show "obtaining" or "stor[ing]," and "index[ing]" threading information.

F. With regards to item (6) above, the prior art does not show specific contents of a "request."

G. With regards to item (7) above, the prior art does not show additional features recited in these claims, such as the "virtual directory" in claim 92. Other distinctive features recited in the other claims will also be brought to the attention of and discussed with the Examiner. Also, the Examiner rejected these claims as containing features that are deemed "obvious by the implementation of the method of claims 50-55 and 57-74." The applicants respectfully disagree with this conclusion, as it is a mis-application of established patent doctrines.

H. With regards to item (7) above, the claims have been amended to address the Examiner's indefiniteness rejections. It may be helpful to discuss these claim amendments with the Examiner during the telephone interview in order to facilitate understanding of the invention.

An interview was conducted on the above-identified application on \_\_\_\_\_.

**NOTE:**

This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP § 713.01).

This application will not be delayed from issue because of applicant's failure to submit a written record of this interview. Therefore, applicant is advised to file a statement of the substance of this interview (37 CFR 1.33(b)) as soon as possible:

\_\_\_\_\_  
(Applicant/Applicant's Representative Signature)

\_\_\_\_\_  
(Examiner/SPE Signature)

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